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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,364	06/02/2000	Mitsuaki Oshima	MTS-520US1	8366

7590 10/29/2002
Ratner & Prestia
PO Box 980
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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/588,364

Applicant(s)

OSHIMA ET AL.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2002 has been entered.

Drawings

2. The corrected or substitute drawings were received on October 5, 2001 (paper number 8). These drawings are accepted.

Response to Amendment

3. The reply filed on 7-02-2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The Amendment is not of proper form as required for reissue applications under 37 CFR 1.173(b)&(d)(1), the matter to be excluded in the amended claim is not contained within brackets and therefore the amendment is non-responsive to the previous Office Action in the case. See MPEP 714.03 and 37 CFR 1.111. Applicant must supply the omission or correction with the next reply to this Office Action in order to avoid abandonment.

Reissue Applications

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The error cited in the declaration; "...the inventors

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did no claim the feature of the reflective layer being trimmed by a laser to form a barcode-like trimming pattern" is not the one corrected by any of the amendments to the claims. None of the amended claims contain all three components of the "feature" described in the reissue oath/declaration of 1. a reflective layer, 2. trimmed by a laser, and 3. formation of a barcode-like pattern.

Claims 1-27, 36 and 37 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Priority

6. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 08/560,015 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

Allowable Subject Matter

7. The following is a statement of reasons for the indication of allowable subject matter:

It is known in the art of DVD technology to include a burst cutting area (BCA) comprising a barcode formed via laser trimming of a reflective layer on an inside track of an optical disk.

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However, the examiner was not able to find a prior art reference earlier than the November 17, 1994 priority date claimed in the applicant's substitute reissue oath/declaration that explicitly discloses BCA formation. This point was discussed in the Interview held with the Applicant's representative on August 29, 2002 (paper No. 15) and noted in the Applicant's separate record of the Substance of the Interview (Paper No. 14). The closest prior art in the field, Wilson U.S. Patent 4,961,007, Kato U.S. Patent 4,503,531, and Ikeda U.S. Patent 5,050, 150, singly and in combination do not teach the feature of a BCA comprising a barcode formed via laser trimming of a reflective layer and formed on a track of an optical disk.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Callahan whose telephone number is (703) 305-13336. The examiner can normally be reached on M-F from 9 to 4.

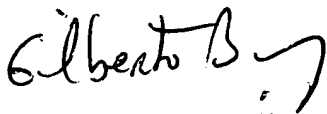
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

PEC

October 25, 2002

Paul Callahan


GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100